

103<sup>D</sup> CONGRESS  
2<sup>D</sup> SESSION

# H. R. 4505

To amend title 35, United States Code, to establish a 20-year patent term from the date of filing and to establish a domestic priority system, and for other purposes.

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## IN THE HOUSE OF REPRESENTATIVES

MAY 26, 1994

Mr. HUGHES (by request) introduced the following bill; which was referred to the Committee on the Judiciary

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## A BILL

To amend title 35, United States Code, to establish a 20-year patent term from the date of filing and to establish a domestic priority system, and for other purposes.

1       *Be it enacted by the Senate and House of Representa-*  
2       *tives of the United States of America in Congress assembled,*

3       **SECTION 1. SHORT TITLE.**

4       This Act may be cited as the “Patent Term Amend-  
5       ment Act of 1994”.

6       **SEC. 2. PATENT TERM.**

7       Section 154 of title 35, United States Code, is  
8       amended to read as follows:

1 **“§ 154 Contents and term of patent**

2       “(a) Every patent shall contain a short title of the  
3 invention and a grant to the patentee, his heirs or assigns,  
4 of the right to exclude others from making, using, or sell-  
5 ing the invention throughout the United States and, if the  
6 invention is a process, of the right to exclude others from  
7 using or selling throughout the United States, or import-  
8 ing into the United States, products made by that process,  
9 referring to the specification for the particulars thereof.  
10 Subject to the payment of fees as provided for in this title,  
11 such grant shall be for a term beginning on the date on  
12 which the patent issues and ending twenty years from the  
13 date on which the application for the patent was filed in  
14 the United States or, if the application contains a specific  
15 reference to an earlier filed application or applications  
16 under sections 120, 121 or 365(c) of this title, from the  
17 date on which the earliest such application was filed. Pri-  
18 ority under sections 119, 365(a) or 365(b) of this title  
19 shall not be taken into account in determining the term  
20 of a patent. A copy of the specification and drawings shall  
21 be annexed to the patent and be a part thereof.

22       “(b) Where the issuance of an original patent is de-  
23 layed because of a proceeding under section 135(a) of this  
24 title or the application is placed under an order pursuant  
25 to section 181 of this title, the term of the patent shall  
26 be extended for the period of delay up to five years. Any

1 and all extensions available under this subsection shall not  
2 extend the term of an original patent for more than five  
3 years.”.

4 **SEC. 3. ESTABLISHMENT OF A DOMESTIC PRIORITY SYS-**  
5 **TEM.**

6 (a) Section 119 of title 35, United States Code, is  
7 amended to read as follows:

8 **“§ 119 Benefit of earlier filing date; right of priority**

9 “(a) An application for patent for an invention filed  
10 in this country by any person who has, or whose legal rep-  
11 resentatives or assigns have, previously filed an applica-  
12 tion for a patent for the same invention in a foreign coun-  
13 try which affords similar privileges in the case of applica-  
14 tions filed in the United States shall have the same effect  
15 as the same application would have if filed in this country  
16 on the date on which the application for patent for the  
17 same invention was first filed in such foreign country, if  
18 the application in this country is filed within twelve  
19 months from the earliest date on which such foreign appli-  
20 cation was filed; but no patent shall be granted on any  
21 application for patent for an invention which had been  
22 patented or described in a printed publication in any coun-  
23 try more than one year before the date of the actual filing  
24 of the application in this country, or which had been in

1 public use or on sale in this country more than one year  
2 prior to such filing.

3       “(b) No application for patent shall be entitled to a  
4 right of priority under subsection (a) unless a claim there-  
5 for and a certified copy of the original foreign application,  
6 specification and drawings upon which it is based are filed  
7 in the Patent and Trademark Office before the patent is  
8 granted, or at such time during the pendency of the appli-  
9 cation as required by the Commissioner not earlier than  
10 six months after the filing of the application in this coun-  
11 try. Such certification shall be made by the patent office  
12 of the foreign country in which filed and show the date  
13 of the application and of the filing of the specification and  
14 other papers. The Commissioner may require a translation  
15 of the papers filed if not in the English language and such  
16 other information as he deems necessary.

17       “(c) In like manner and subject to the same condi-  
18 tions and requirements, the right provided under sub-  
19 section (a) may be based upon a subsequent regularly filed  
20 application in the same foreign country instead of the first  
21 filed foreign application, provided that any foreign applica-  
22 tion has been withdrawn, abandoned, or otherwise dis-  
23 posed of, without having been laid open to public inspec-  
24 tion and without leaving any rights outstanding, and has

1 not served, nor thereafter shall serve, as a basis for claim-  
2 ing a right of priority.

3 “(d) Applications for inventor’s certificates filed in a  
4 foreign country in which applicants have a right to apply,  
5 at their discretion, either for a patent or for an inventor’s  
6 certificate shall be treated in this country in the same  
7 manner and have the same effect for purpose of the right  
8 of priority under subsection (a) as applications for pat-  
9 ents, subject to the same conditions and requirements of  
10 this section as apply to applications for patents, provided  
11 such applicants are entitled to the benefits of the Stock-  
12 holm Revision of the Paris Convention at the time of such  
13 filing.

14 “(e) An application for patent filed under sections  
15 111(a) or 363 of this title for an invention disclosed in  
16 the manner provided by the first paragraph of section 112  
17 of this title in a provisional application filed under section  
18 111(b) of this title, by an inventor or inventors named  
19 in the provisional application shall have the same effect,  
20 as to such invention, as though filed on the date of the  
21 provisional application filed under section 111(b) of this  
22 title, if the application for patent filed under sections  
23 111(a) or 363 of this title is filed within twelve months  
24 from the date on which the provisional application was  
25 filed and if it contains or is amended to contain a specific

1 reference to the provisional application. A provisional ap-  
2 plication filed under section 111(b) of this title may not  
3 be relied upon in any proceeding in the Patent and Trade-  
4 mark Office unless the fee set forth in subsections  
5 41(a)(1) (A) or (C) has been paid and the provisional ap-  
6 plication was pending on the filing date of the application  
7 for patent under sections 111(a) or 363 of this title.”.

8 (b) Section 41(a)(1) of title 35, United States Code,  
9 is amended to include a new subparagraph c, as follows:

10 “c. On filing each provisional application for an  
11 original patent, \$150.00.”.

12 (c) Section 111 of title 35, United States Code, is  
13 amended to read as follows:

14 **“§ 111 Application**

15 “(a) Application for patent shall be made, or author-  
16 ized to be made, by the inventor, except as otherwise pro-  
17 vided in this title, in writing to the Commissioner. Such  
18 application shall include (1) a specification as prescribed  
19 by section 112 of this title; (2) a drawing as prescribed  
20 by section 113 of this title; and (3) an oath by the appli-  
21 cant as prescribed by section 115 of this title. The applica-  
22 tion must be accompanied by the fee required by law. The  
23 fee and oath may be submitted after the specification and  
24 any required drawing are submitted, within such period  
25 and under such conditions, including the payment of a

1 surcharge, as may be prescribed by the Commissioner.  
2 Upon failure to submit the fee and oath within such pre-  
3 scribed period, the application shall be regarded as aban-  
4 doned, unless it is shown to the satisfaction of the Com-  
5 missioner that the delay in submitting the fee and oath  
6 was unavoidable or unintentional. The filing date of an  
7 application shall be the date on which the specification and  
8 any required drawing are received in the Patent and  
9 Trademark Office.

10 “(b)(1) A provisional application for patent shall be  
11 made, or authorized to be made, by the inventor, in ac-  
12 cordance with regulations prescribed by the Commissioner.  
13 Such application shall include (A) a specification as pre-  
14 scribed by the first paragraph of section 112 of this title;  
15 and (B) a drawing as prescribed by section 113 of this  
16 title. A claim shall not be required in a provisional applica-  
17 tion. The application must be accompanied by the fee re-  
18 quired by law. The fee may be submitted after the speci-  
19 fication and any required drawing are submitted, within  
20 such period and under such conditions, including the pay-  
21 ment of a surcharge, as may be prescribed by the Commis-  
22 sioner. Upon failure to submit the fee within such pre-  
23 scribed period, the application shall be regarded as aban-  
24 doned, unless it is shown to the satisfaction of the Com-  
25 missioner that the delay in submitting the fee was un-

1 avoidable or unintentional. The filing date of a provisional  
2 application shall be the date on which the specification and  
3 any required drawing are received in the Patent and  
4 Trademark Office. The provisional application shall be re-  
5 garded as abandoned twelve months after its filing date  
6 and shall not be subject to revival thereafter. Subject to  
7 all the conditions in this subsection, subsections 111(b)(2)  
8 and 119(e) and as prescribed by the Commissioner, an ap-  
9 plication for patent filed under section 111(a) of this title  
10 may be treated as a provisional application for patent.

11 “(2) A provisional application shall not be entitled to  
12 the right of priority of any other application under sec-  
13 tions 119 or 365(a) of this title or the benefit of an earlier  
14 filing date in the United States under sections 120, 121  
15 or 365(c) of this title.

16 “(3) The provisions of this title relating to applica-  
17 tions for patent shall be applicable to provisional applica-  
18 tions for patent, except as otherwise provided and except  
19 that provisional applications for patent shall not be subject  
20 to sections 115, 131, 135 and 157 of this title.”.

21 **SEC. 4. CONFORMING CHANGES.**

22 (a) The table of sections for chapter 11 of title 35,  
23 United States Code, is amended in the item relating to  
24 section 111 by deleting “for patent” and in the item relat-  
25 ing to section 119 by deleting “in foreign country.”



1 (b) Section 156 of title 35, United States Code, is  
2 amended by adding “under subsection (e)(1) of this sec-  
3 tion” after “extended” in subsection (a)(2).

4 (c) Section 172 of title 35, United States Code, is  
5 amended by changing “section 119” to “subsections  
6 119(a) through 119(d)”. Further, “The right of priority  
7 provided for by subsection 119(e) of this title shall not  
8 apply to designs.” has been added as a second sentence.

9 (d) Section 173 of title 35, United States Code, is  
10 amended by adding “from the date of grant” after  
11 “years.”

12 (e) Subsection 365(a) of title 35, United States Code,  
13 is amended by changing “section 119” to “subsections  
14 119(a) through 119(d)” and subsection 365(b) of title 35,  
15 United States Code, is amended by changing “the first  
16 paragraph of section 119” to “subsection 119(a).”

17 (f) Subsection 373 of title 35, United States Code,  
18 is amended by changing “section 119” to “subsections  
19 119(a) through 119(d)”.

20 **SEC. 5. EFFECTIVE DATE.**

21 Sections 2 through 4 shall take effect six months  
22 from the date of enactment and shall apply to all applica-  
23 tions filed in the United States on or after the effective  
24 date. The term of a patent granted on a plant or utility  
25 application that is filed after the effective date and that

1 contains a specific reference to an earlier filed application  
2 under the provisions of sections 120, 121 or 365(c) of title  
3 35 shall be measured from the filing date of the earliest  
4 filed application, a reference to which is made under sec-  
5 tions 120, 121 or 365(c) of this title.